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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/391,966 09/08/99 DITZIK

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WM02/0606

EXAMINER

URBAN, E

ART UNIT

PAPER NUMBER

2683

DATE MAILED:

06/06/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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# Office Action Summary

Application No.

09/391,966

Applicant

Ditzlik

Examiner

Edward F. Urban

Art Unit

2683



– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on Mar 2, 2001

2a) ☐ This action is FINAL.

2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 13-24 and 26-39 is/are pending in the application

4a) Of the above, claim(s) 13, 15-22, 26-30, and 32-39 is/are withdrawn from consideration

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 14, 23, 24, and 31 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirements.

## Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some\* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

20) ☐ Other:

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 14,23-24 and 31, drawn to a portable wireless communication device, classified in class 455, subclass 557.
  - II. Claims 32-36, drawn to a computer communications base unit which controls local as well as long distance communications relaying, classified in class 455, subclass 11.1.
  - III. Claims 37-39, drawn to wirelessly communicating data and executing local area network functions among a computer base unit and multiple wireless communication devices, classified in class 370, subclass 338.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions I, II and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the details of the computer communications base unit found in claims 32-39 are not required in the portable wireless communication device of claims 14,23-24 and 31. The subcombination has separate

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utility such as the ability to simultaneously control computer and communications modes in a hand held computer of invention I and using a computer communications base unit as a relaying device for multiple wireless communication devices.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Groups II and III, restriction for examination purposes as indicated is proper.

Since applicant has elected the group associated with claims 14,23-24 and 31, the following is an action on the merits for claims 14,23-24 and 31.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
7. Claim 14, 23-24 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Siitonen.

As to claim 14, Siitonen discloses a technique for controlling a computer-display handset, or hand held unit, which can be in the form of a PDA or cellular phone unit as recited in claims 23-24 (figures 2A, 2B) operated by a user in which an operating system is used for controlling the display as well as accepting user inputs and processing outputs. Also disclosed is the features of selecting from a plurality of computing and communication modes, such as wireless data, wireless voice and conventional computing functions as well as a plurality of program functions such as e-mail functions, voice communications and telephony functions (col. 2, line 15 - col. 3, line 48). Siitonen does not specifically disclose that these modes are run "roughly" simultaneously. However, since Siitonen et al. essentially discloses that the computer functions for the PDA are separate from the communication functions of the cellular telephone, then it would have been obvious to one having ordinary skill in the art to specifically run these functions simultaneously since the capability to do so is apparent and since one would like to receive a wireless call while the PDA is in operation. Also disclosed by Siitonen et al. is the ability to communicate with other units in the communications mode as recited in claim 31 (col. 2, lines 15-29).

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***Claim Rejections - 35 USC § 112***

8. Claims 14,23-24 and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 14, it is unclear as to what the device is called, since it is referred to differently in numerous occasions. For example, in line 1, the device claimed is called a "computer display handset unit" and in line 11, the device is called a "hand held computer display unit". It is suggested to adhere to one descriptive label for clarity purposes.

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Grimm et al., Metso et al. and Folodare et al. all disclose particular combination cellular telephone/PDA units.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Urban whose telephone number is (703) 305-4385.

EFU

June 3, 2001

  
EDWARD F. URBAN  
PRIMARY EXAMINER